



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Timothy T. Achee, Jr. et al. § Art Unit: 3672
Serial No.: 10/709,755 §
Filed: May 26, 2004 § Examiner: Giovanna M. Collins
For: Flow Control in Conduits from § Atty. Dkt. No.: SHL.0301US (68.0475)
Multiple Zones of a Well §

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

Each of independent claims 1, 9, and 20 was rejected as being obvious over Patel '298 alone. It is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness for at least the reason that no motivation or suggestion existed to modify Patel '298 to achieve the claimed subject matter. See M.P.E.P. § 2143 (8th ed., Rev. 3), at 2100-135.

As conceded by the Office Action, Patel '298 does not disclose all of the subject matter of claim 1. 3/9/2005 Office Action at 2. Specifically, Applicant respectfully submits that Patel '298 does not disclose or suggest that each of at least *two* of the three flow conduits includes an *annular path*. Although Patel '298 does state that further embodiments may include multiple valves for use with more than two zones (Patel '298, 2:24-27), Patel '298 does not disclose or suggest that the addition of flow conduits would include another *annular path*. In other words, Applicant respectfully submits that Patel '298 does not suggest a flow assembly defining at least

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three flow conduits to respectively communicate with at least three zones, where each of at least *two* of the flow conduits includes an *annular* path.

Using the benefit of impermissible hindsight reconstruction, the Office Action stated that “it would be advantageous to have at least sand control assemblies, flow conduits and flow control devices when using the apparatus in a system [sic] at least three zones of interest and to have a second annular path for the third flow conduit to ensure the isolation of the zone,” and that therefore, “it would be obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus disclosed [sic] by Patel [’298] to have at least three sand control assemblies, flow conduits and flow control devices and a second annular path.” 3/9/2006 Office Action 2-3. This logic for supporting the obviousness rejection of the claims over Patel ’298 does not rely on any objective evidence, but rather relies upon speculation on the part of the Examiner. What the Office Action failed to appreciate is the complexity of completion hardware associated with completing a well with multiple zones, particularly when sand control has to be performed. *See* Specification, ¶ [0002]. By using a flow control assembly according to some embodiments of the invention, convenient placement of flow control devices in conjunction with sand control equipment can be accomplished. *Id.* at ¶ [0030]. Except for a mere reference in Patel ’298 that multiple valves can be used with more than two zones, the Office Action has failed to cite to any objective evidence that would have suggested a modification of Patel ’298 to provide a second annular path that is part of the claimed subject matter. As consistently warned by the courts, “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). That appears to be exactly what has been performed here, with the present invention used as a template for the purpose of modifying Patel ’298, where no objective evidence has been cited to support the allegation in the Office Action that it would be obvious to modify Patel ’298 to incorporate the second annular path recited in the claims.

In the previous Response to Office Action, Applicant specifically requested production of a reference that would have suggested a modification of Patel ’298 to achieve the claimed invention. Despite this request, no such reference has been cited in the present Office Action. Therefore, it is respectfully submitted that independent claims 1, 9, and 20 are allowable over Patel ’298.


Dependent claims are allowable for at least the same reasons as corresponding independent claims.

In view of the allowability of the base claims over Patel '298, it is respectfully submitted that dependent claims 19, 22, and 23 are non-obvious over Patel '298 and Patel '216.

In view of the foregoing, withdrawal of all final rejections is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0301US).

Respectfully submitted,

Date May 12, 2006



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